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PATENT
Attorney Docket No. 214348
Client Reference No. 20848

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Ikemoto et al.

Application No. 09/992,167

Art Unit: 1625

Examiner: H. M. Reyes

Filed: November 6, 2001

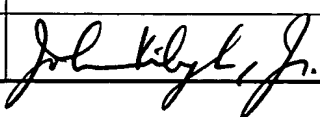
For: PRODUCTION METHOD OF 2-
CYCLOHEXYL-2-HYDROXY-2-
PHENYLACETIC ACID,
INTERMEDIATE THEREFOR AND
PRODUCTION METHOD THEREOF

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated June 3, 2003, please consider the following remarks.

CERTIFICATE OF MAILING UNDER 37 CFR 1.8			
I hereby certify that this Response to Restriction Requirement and all accompanying documents are, on the date indicated below, being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.			
Name (Print/Type)	John Kilyk, Jr.		
Signature		Date	July 1, 2003

REMARKS

The Office Action sets forth a restriction requirement between the following groups of claims:

- ✓ (I) claims 1, 2, and 4-9;
- ✓ (II) claims 3, 12, 13, 22, and 23;
- (III) claims 10, 11, 20, and 21; and
- (IV) claims 14-19 and 24-28.

Applicants thank Examiner Reyes for granting an Examiner interview on June 26, 2003, to discuss the restriction requirement with one of applicants' representatives, Kristen J. Harrell. The Examiner agreed in the course of the telephone interview to consider the claims of Groups I and II at the same time. Accordingly, as discussed in the telephone interview, and as agreed upon by the Examiner, applicants elect claims 1-3, 4-9, 12, 13, 22, and 23 of collapsed Groups I and II for examination.

The election is with traverse for the following reason. The elected claims, specifically claims 1 and 3, are directed to compounds of the formulas [II] and [V]. The nonelected claims, i.e., the claims of Groups III and IV, refer to these same compounds, albeit in the context of production methods. If elected claims 1 and 3 are determined to be patentable, the compounds of the formulas [II] and [V] must be novel and unobvious. Since the claimed methods involve the use of the compounds of formulas [II] and [V], in such an event the nonelected claims also must be novel and unobvious even though the nonelected claims of Groups III and IV are production method claims. Only matters of form as to the nonelected claims then would remain for the Examiner to consider, which could be done without an undue burden being placed on the Examiner. See, e.g., M.P.E.P. § 803 ("If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."). Under the circumstances, applicants respectfully request the withdrawal of the restriction requirement, particularly if claims 1 and/or 3 are found to be allowable.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

In re Appl. of Ikemoto et al.
Application No. 09/992,167

Respectfully submitted,



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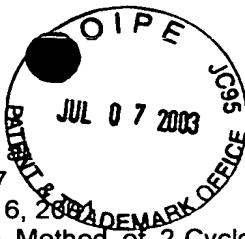
Date: July 1, 2003

In re Application of: Ikemoto et al.

Application No. 09/992,167

Filed: November 6, 2001

For: Production Method of 2-Cyclohexyl-2-Hydroxy-2-Phenylacetic Acid, Intermediate Therefor and Production Method Thereof



Mail Stop Non-Fee Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a response to an office action in the subject application.

☐ Applicants claim small entity status of this application under 37 CFR 1.27.☒ Petition for Extension of Time☐ Applicants petition for a one-month extension of time under 37 CFR 1.136, the fee for which is \$110.00 (enclosed).☒ Applicants believe that no petition for an extension of time is necessary. However, to the extent that such petition is deemed necessary, Applicants hereby petition for a sufficient extension of time to render the present submission timely. Please charge Deposit Account No. 12-1216 for the appropriate petition fee.☒ No additional claim fee is required.☐ Other:

The claim fee has been calculated as shown below:

The claim fee has been calculated as shown below.

					SMALL ENTITY		OTHER THAN A SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	EXTRA CLAIMS PRESENT	RATE	ADDIT. CLAIM FEE	RATE	ADDIT. CLAIM FEE
TOTAL	13	MINUS	28	=0	x 9=	\$	x 18=	\$0.00
INDEPENDENT	2	MINUS	3	=0	x 42=	\$	x 84=	\$0.00
<input type="checkbox"/>	FIRST PRESENTATION OF MULTIPLE CLAIM				+ 140=	\$	+ 280=	\$0.00
					TOTAL	\$	TOTAL	\$0.00

☐ Please charge my Deposit Account No. 12-1216 in the amount of \$. A duplicate copy of this sheet is attached.☐ A check in the amount of \$ is attached.☒ The Commissioner is hereby authorized to charge any deficiencies in the following fees associated with this communication or credit any overpayment to Deposit Account No. 12-1216. A duplicate copy of this sheet is attached.☒ Any filing fees under 37 CFR 1.16 for the presentation of extra claims.☒ Any patent application processing fees under 37 CFR 1.17.Respectfully submitted,
LEYDIG, VOIT & MAYER, LTD.

By

John Kilyk, Jr., Reg. No. 30763

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